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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,755	10/12/2005	Andrew Paul Shawcross	056258-5094	7346
9629 7590 06/06/2008 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				
EXAMINER				
SHAH, MANISH S				
ART UNIT		PAPER NUMBER		
2853				
MAIL DATE		DELIVERY MODE		
06/06/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/530,755

**Applicant(s)**

SHAWCROSS ET AL.

**Examiner**

Manish S. Shah

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

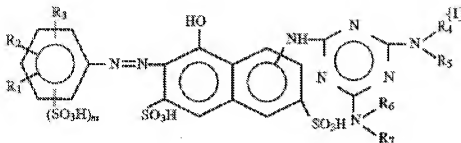
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Satoh et al. (# US 5713992).

Satoh et al. discloses a compound an ink composition including from 0.5 to 5% the water soluble dye (column: 22, line: 55-65) and from 35 to 75% of water and 10 to 50% of solvent (column: 23, line: 1-25). They also disclose process of inkjet printing using inkjet recording apparatus, which includes ink cartridge (column: 23, line: 30-45; see Examples), and ink composition, and ejecting ink on paper or synthetic fiber (column: 23, line: 40-45). They also disclose that the water soluble dye of a formula as shown below (see Abstract). They also disclose that the formula is in form of lithium, sodium or potassium salt (see formula 1-63).

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(wherein  $R_1$ ,  $R_2$ , and  $R_3$  each independently represents a substituted or unsubstituted alkyl group having 1 to 9 carbon atoms, an alkoxy group having 1 to 9 carbon atoms, a halogen atom, a hydrogen atom, a hydroxyl group, a substituted or unsubstituted carbamoyl group, a substituted or unsubstituted sulfamoyl group, a substituted or unsubstituted amino group, a nitro group, a sulfonic ester group, a sulfonyl group, a COOH group, or a carboxylic ester group;

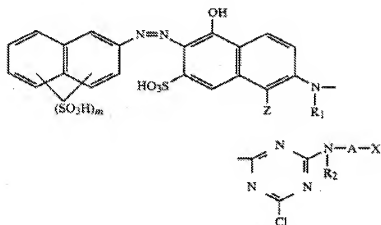
$m$  represents a number of 0, 1, or 2; and

$R_4$ ,  $R_5$ ,  $R_6$ , and  $R_7$  each independently represents a hydrogen atom, an alkyl group having 1 to 18 carbon atoms, an alkenyl group having 1 to 18 carbon atoms, an aryl group, an aralkyl group, an alicyclic group, or a heterocyclic group, and each may have a substituent when not representing a hydrogen atom, provided that at least one of  $R_4$ ,  $R_5$ ,  $R_6$ , and  $R_7$  represents a group having a COOH group as a substituent).

Claims 1-5 & 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Kayane et al. (# US 4841031).

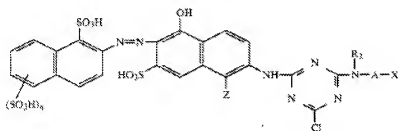
Kayane et al. discloses a compound of formula as shown below: (see Abstract; column: 3, line: 1- to column: 4, line: 60, formula III).

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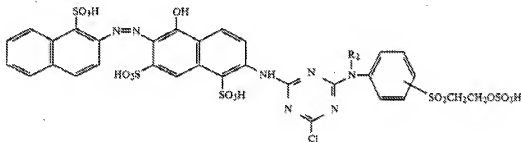
wherein  $R_1$  is hydrogen, methyl or ethyl;  $R_2$  is an alkyl having 1 to 4 carbons that is either unsubstituted or substituted with hydroxy, cyano, alkoxy, halogen, carboxy, alkoxycarbonyl or sulfonic acid; Z is hydrogen or sulfonic acid; A is phenylene and is either unsubstituted or substituted with 1 or 2 substituents selected from the group consisting of methyl, ethyl, methoxy, ethoxy, chlorine, bromine and sulfonic acid, or naphthylene that is either unsubstituted or substituted with sulfonic acid; X is  $-\text{SO}_2\text{CH}=\text{CH}_2$  or  $-\text{SO}_2\text{CH}_2\text{CH}_2\text{Y}$  in which Y is a group that is splittable by alkalis; and m is an integer of 1 to 3.

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wherein  $R_2$ , A, X and Z are as defined above, and n is 0 or 1, more specifically, those having the following 15 formula,

(III)



### Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manish S. Shah whose telephone number is (571) 272-2152. The examiner can normally be reached on 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Manish S. Shah/  
Primary Examiner  
Art Unit 2853

/MSS/